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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

11664-0004-999

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Application Number

10/039,855

Filed

October 19, 2001

First Named Inventor

John K. Billock et al.

Art Unit

2424

Examiner

Annan Q. Shang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

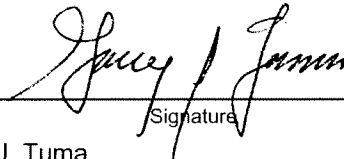
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 40,210

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Garry J. Tuma

Typed or printed name

212-326-7845

Telephone number

March 31, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants:	John K. Billock et al.	Confirmation No.:	1770
Application No.:	10/039,855	Art Unit:	2424
Filed:	October 19, 2001	Examiner:	Annan Q. Shang
For:	VIDEO-ON-DEMAND SERVICE WITH AN INTERACTIVE INTERFACE FOR FACILITATING VIEWER SELECTION OF VIDEO PROGRAMS	Attorney Docket:	11664-0004-999

New York, New York 10017
March 31, 2010

Mail Stop AF
Hon. Commissioner for Patents
P.O. Box 1450
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REMARKS FOR PRE-APPEAL BRIEF CONFERENCE

Sir:

Applicants hereby request review of all rejections in the February 3, 2010 final Office Action ("FOA"), because prima facie obviousness has not been established.

Claims 1-38 are pending and stand rejected under 35 U.S.C. §103(a) as being obvious from Hendricks U.S. Patent Application Publication No. 2005/0157217 ("Hendricks").

Operational Differences Between Applicants' Invention And Hendricks

Applicants claim video-on-demand ("VOD") services and methods of operating VOD services that are accessible by subscribers and non-subscribers of those services. A VOD service responds to requests from viewers for programs or previews by transmitting the selected programs or previews to the set top terminal of the viewer that made the request.

Hendricks discloses a near-video-on-demand ("NVOD") service in connection with a television program delivery system. An NVOD service broadcasts a same program on

multiple channels at staggered start times to all subscribers of the service. When a subscriber selects the broadcasted program, the NVD service tunes the subscriber's set top terminal to the channel scheduled to show the program at the next start time. (See applicants' October 16, 2009 Reply To Office Action ("RTOA"), pages 13-14.) Notably, Hendricks discloses that "a subscriber may tape movies which are shown at inconvenient start times for later viewing" (paragraph 317; emphasis added).

A significant advantage of applicants' VOD service is that viewers can select and view programs at a time of their choosing – in contrast to NVD services, where the NVD service provider chooses what programs to broadcast and when to broadcast them.

Independent Method Claims 1, 10, 16, 19, and 36

Independent claims 1, 10, 16, 19, and 36 require a VOD service to be accessible to non-subscribers of the VOD service.

The Examiner asserted that Hendricks' "service [is] accessible to ... non-subscribers of the service" (FOA, page 2). The Examiner is wrong.

Hendricks is plainly directed to only subscribers of its program delivery system and does not disclose or suggest in any way that its system is accessible to non-subscribers. Indeed, Hendricks does not even disclose or suggest how a non-subscriber of its program delivery system can become a subscriber (*see* RTOA, page 15).

The Examiner cited Hendricks' paragraphs 282, 284, and 288 – however, these paragraphs also refer to only "subscribers" of the program delivery system (*see* RTOA, pages 15-16).

Moreover, the Examiner acknowledged that "Hendricks is silent as to specific use of the phrase 'non-subscriber' in the disclosure" (FOA, page 4).

The Examiner then admitted that the “disclosure clearly discloses a system which permits subscriber(s) to instantly subscribe to non-subscribe program(s)/channels” (FOA, page 4; emphasis added). The Examiner is referring to Hendricks’ FIGS. 30-32, which illustrate the feature of subscribers ordering specialty channels. However, a subscriber who does not order a specialty channel is still a subscriber of Hendricks’ program delivery system.

Applicants have made clear in their claims that the term “non-subscriber” refers to the VOD service and not a particular feature of the service.

Furthermore, Hendricks makes clear that only subscribers in good standing may order programs or specialty channels:

“When a subscriber orders a program or channel ... controller 214 checks the subscriber’s account for good standing and then authorizes the access by signaling the set top terminal 220” (paragraph 134, lines 7-10; emphasis added).

Thus, Hendricks plainly teaches away from allowing non-subscribers – who have no account and no standing – to order and view programs.

Accordingly, there is no factual support for the Examiner’s assertion that Hendricks’ program delivery system is accessible to non-subscribers of that system.

Independent Method Claims 1 and 19

Independent claims 1 and 19 also require “preventing transmission of one of said video programs to said viewing station” when that program is selected by a non-subscriber.

The Examiner asserted that Hendricks “prevents transmission of one of the video programs to the viewing station when the ... selection of the one video program [is] by one of the non-subscribers” (FOA, page 3). The Examiner is again wrong.

Aside from non-subscribers not having access to Hendricks’ system, Hendricks does not prevent the transmission of any program regardless of who selected it.

When a subscriber selects an NVD program or specialty channel, Hendricks' system decides whether or not to tune the subscriber's set top terminal to the particular channel carrying the selected programming.

Hendricks does not prevent transmission of the selected program or specialty channel to the subscriber's set top terminal if, for example, the subscriber's account is not in good standing. To the contrary, Hendricks continuously transmits NVD programming and specialty channels to all subscriber set top terminals regardless of whether or not any particular subscriber selects the programming or is denied access to the particular channel carrying that programming (*see* RTOA, pages 18-21).

In contrast, applicants' VOD service will not transmit a full-length program to a viewer's set top terminal if the viewer who selected the program is not a subscriber. This is a fundamental difference between the operation of Hendricks and applicants' service.

Again, there is no factual support for the Examiner's assertion that Hendricks' program delivery system prevents transmission of a program selected by a non-subscriber.

Independent Claims 7, 14, 21, and 36

Independent claims 7, 14, and 21 require previews to be transmitted on demand to non-subscribers of the VOD service without the non-subscribers having to become subscribers.

Independent claim 36 similarly requires a program segment (e.g., a preview) to be displayed in response to a selection of that segment by a non-subscriber without the non-subscriber having to become a subscriber.

Hendricks does not in any way disclose or suggest that a non-subscriber can view previews or program segments on demand without having to become a subscriber.

The Examiner ignored this feature in the rejections of these claims.

However, the Examiner cited Hendricks' FIGS. 30-32 and stated: "Figures 30-32 illustrate[] where upon receiving [a] [n]on-subscriber request, the system subscribes the subscriber and displays a message 'Thank you for subscribing!'" (FOA, pages 8-9; emphasis added). Thus, regardless of whether or not the viewer is considered a "non-subscriber," upon selecting the programming offered in FIG. 31, that viewer becomes a subscriber.

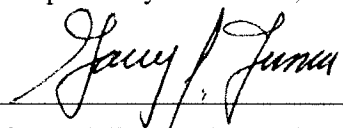
Moreover, Hendricks does not disclose or suggest that previews can be provided on-demand to non-subscribers of the program delivery system (*see* RTOA, pages 23-25).

Accordingly, the Examiner's rejection of these claims is completely baseless.

Conclusion

Notwithstanding the above, if Hendricks were modified as indicated by the Examiner (*i.e.*, from broadcasting specialty channels and NVOD programs to all subscriber set top terminals and determining whether to grant access to requested channels – to (1) receiving requests for VOD programs or previews, (2) determining whether to transmit the requested programs or previews, and (3) transmitting a requested program or preview to a specific set top terminal), such modifications would impermissibly change the basic principle under which Hendricks operates – *i.e.*, from an NVOD system to a VOD system. Hendricks is therefore not sufficient to render the claims prima facie obvious. MPEP §2143.01(VI).

Respectfully submitted,



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